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09/764,160

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Tetsuo Minakawa

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07/25/2005

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EXAMINER

PHAM, THOMAS K

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,160

Applicant(s)

MINAKAWA ET AL.

Examiner

Thomas K. Pham

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____



Response to Amendment

1. This action is in response to request for re-consideration filed on 05/06/2005.
2. Applicant amendment, with respect to the new issues of claims 1, 10, 11 12, 13 and 16, necessitated the new ground(s) of rejection presented in this Office Action.

Quotations of U.S. Code Title 35

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 102

5. Claim 1-4, 10-13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,845,448 ("Chaganti").

Regarding claim 1

Chaganti teaches an intermediation control apparatus that carries out intermediation between a user and a service provider (col. 2 lines 18-22), the intermediation control apparatus comprising:

- extraction means for determining a range of permitted personal information of a user, for disclosure, based on a kind of an insurance request information sent from said user (col. 1 lines 34-39 and col. 7 lines 42-50), using a table which defines a correlation between the kind of said insurance and respective sets of personal information being permitted to be disclosed (col. 7 lines 35-41), and extracting said range of personal information from said personal information from said personal information (col. 10 lines 54-58); and
- transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 10 lines 48-54).

Regarding claim 10

Chaganti teaches a computer-readable recording medium which stores an intermediation control program for causing a computer to execute intermediation control, said intermediation control program causing said computer to execute operations (col. 2 lines 18-22), comprising:

- extraction means for determining a range of permitted personal information of a user, for disclosure, based on a kind of an insurance request information sent from said user (col. 1 lines 34-39 and col. 7 lines 42-50), using a table which defines a correlation between the kind of said insurance and respective sets of personal information being permitted to be

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disclosed (col. 7 lines 35-41), and extracting said range of personal information from said personal information from said personal information (col. 10 lines 54-58); and

- transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 10 lines 48-54).

Regarding claim 11

Chaganti teaches a method of intermediation control between a user and at least one service provider (col. 2 lines 18-22), comprising:

- determining a range of permitted personal information of a user, for disclosure, based on a kind of an insurance request information sent from said user (col. 1 lines 34-39 and col. 7 lines 42-50), using a table which defines a correlation between the kind of said insurance and respective sets of personal information being permitted to be disclosed (col. 7 lines 35-41);
- extracting said range of personal information from said personal information from a personal information storage (col. 10 lines 54-58); and
- making the extracted range of personal information and the insurance request information available to the at least one service provider (col. 10 lines 48-54).

Regarding claim 12

Chaganti teaches an intermediation control method between a user and at least one service provider, comprising:

- generating a look-up table having information regarding insurance requests from a user (col. 1 lines 34-39 and col. 7 lines 42-50), wherein the information is correlated with items of disclosure using a table which defines a correlation between the kind of said

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insurance and respective sets of personal information being permitted to be disclosed (col. 7 lines 35-41); and

- extracting a range of information of a user based on an insurance request sent by the user and the correlation (col. 10 lines 54-58), and providing the extracted range of information to the at least one service provider (col. 10 lines 48-54).

Regarding claim 13

Chaganti teaches an intermediation control apparatus between a user and at least one service provider, comprising:

- an extraction unit determining a range of permitted personal information of a user based on a type of an insurance request information sent by the user to the at least one service provider (col. 1 lines 34-39 and col. 10 lines 54-58) using a table which defines a correlation between the kind of said insurance and respective sets of personal information being permitted to be disclosed (col. 7 lines 35-41); and
- a transaction unit providing the extracted range of permitted personal information of the user to the at least one service provider (col. 10 lines 48-54).

Regarding claim 16

Chaganti teaches a method of intermediation control between a user and at least one service provider, comprising:

- automatically determining a range of personal information of a user to be disclosed upon receipt of an insurance request from the user (col. 1 lines 34-39 and col. 7 lines 42-50) using a table which defines a correlation between the kind of said insurance and

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respective sets of personal information being permitted to be disclosed (col. 7 lines 35-41); and

- extracting said range of personal information from stored personal information based on the insurance request from the user (col. 10 lines 54-58) and providing the extracted range of personal information of the user to the at least one service provider (col. 10 lines 48-54).

Regarding claim 2

Chaganti teaches memory means for storing said personal information together with a user ID of said user (col. 9 lines 49-53).

Regarding claim 3

Chaganti teaches extraction means is responsive to said insurance request information including said user ID, for determining disclosure information of said personal information stored in said storage means based on said user ID and said kind of said request information, and extracting said disclosure information from said personal information (col. 9 lines 53-64).

Regarding claim 4

Chaganti teaches transaction means makes said extracted range of personal information and said contents of said insurance request available to said service provider on a site where said service provider is permitted to access through authentication (col. 10 lines 43-58).

Response to Arguments

In response to applicant's arguments,

Chaganti (USPN 6,845,448) teaches an intermediation system between a user and a service provider to provide the user's personal information depend on the type of services (including insurance services – see col. 1 lines 35-39) being provided and a user's provided security access key for extracting a range of permitted personal information from the intermediation system automatically see for example column 10 lines 43-58. Therefore, Chaganti system is similar or at least having all the claimed limitations of the present application.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday to Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham

Patent Examiner



July 18, 2005



Anthony Knight
Supervisory Patent Examiner
Group 3600